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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,555	06/01/2007	Allan Svendsen	10517.204-US	5093
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EXAMINER				
SWOPE, SHERIDAN				
ART UNIT		PAPER NUMBER		
1652				
NOTIFICATION DATE		DELIVERY MODE		
10/20/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents-US-NY@novozymes.com

Office Action Summary

Application No.

10/588,555

Applicant(s)

SVENDSEN ET AL.

Examiner

SHERIDAN SWOPE

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77-106 is/are pending in the application.
- 4a) Of the above claim(s) 79-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77 and 78 is/are rejected.
- 7) ☒ Claim(s) 77 and 78 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 0909
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants' filing of September 8, 2009, in response to the Action of April 8, 2009 is acknowledged. It is acknowledged that Claims 47-76 are cancelled and Claims 77-106 are added. Claims 77-106 are pending. As stated in the Action of October 28, 2008, the elected invention is directed to the RP-II protease variant of SEQ ID NO: 2 having only a H¹⁴⁴R substitution. Claims 79-106 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Claims 77 and 78 are hereby examined.

Claims-Objections

Claims 77 and 78 are objected to for reciting non-elected subject matter.

Claim Rejections - 35 USC § 112-Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 78 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the following reasons.

For Claim 78, "The variant" is improper antecedent usage and should be corrected to "The isolated variant".

Examiner's note: Regarding the phrase "RP-II protease activity" in Claim 77, it is assumed that said activity is glutamic-acid-specific endopeptidase activity, as stated in the specification [0005].

Claim Rejections - 35 USC § 112-First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Enablement

Claims 77 and 78 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the variant of SEQ ID NO: 2 having only a H¹⁴⁴R substitution, does not reasonably provide enablement for any protein, having any structure with a substitution corresponding to H¹⁴⁴R of SEQ ID NO: 2, wherein the protein has glutamic-acid-specific endopeptidase (RP-II) activity. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In regards to this enablement rejection, the application disclosure and claims are compared per the factors indicated in the decision *In re Wands* 858 F.2d 731, 8 USPQ2nd 1400 (Fed. Cir, 1988). These factors are considered when determining whether there is sufficient evidence to support a description that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is undue. The factors include but are not limited to: (1) the nature of the invention; (2) the breadth of the claims; (3) the predictability or unpredictability of the art; (4) the amount of direction or guidance presented; (5) the presence or absence of working examples; (6) the quantity of experimentation necessary; (7) the relative skill of those skilled in the art. Each factor is here addressed on the basis of a comparison of the disclosure, the claims, and the state of the prior art in the assessment of undue experimentation.

Claims 77 and 78 are so broad as to encompass any protein, having any structure with a substitution corresponding to H¹⁴⁴R of SEQ ID NO: 2, wherein the protein has RP-II activity. The scope of these claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of proteins broadly encompassed by the claim. Since the amino acid sequence of a protein determines its structural and functional properties, predictability of which changes can be tolerated in a protein's amino acid sequence and obtain the desired RP-II activity requires a knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (i.e. expectedly intolerant to modification), and detailed knowledge of the ways in which the protein's structure relates to its function. However, in this case the disclosure is limited to the variant of SEQ ID NO: 2 having only a H¹⁴⁴R substitution.

While recombinant and mutagenesis techniques are known, it is not routine in the art to screen for multiple substitutions or multiple modifications, as encompassed by the instant claims. Furthermore, the positions within a protein's sequence where amino acid modifications can be made with a reasonable expectation of success in obtaining the desired activity/utility are limited in any protein and the results of such modifications are unpredictable (Galye et al, 1993; Whisstock et al, 2003). In addition, one skilled in the art would expect any tolerance to modification for a given protein to diminish with each further and additional modification, e.g. multiple substitutions.

The specification does not support the broad scope of Claims 77 and 78, which encompasses all proteins, having any structure with a substitution corresponding to H¹⁴⁴R of SEQ ID NO: 2, wherein the protein has RP-II activity. The specification does not support the

broad scope of Claims 77 and 78 because the specification does not establish: (A) regions of the protein structure which may be modified without affecting the RP-II activity; (B) the general tolerance of the RP-II activity to modification and extent of such tolerance; (C) a rational and predictable scheme for modifying any residues with an expectation of obtaining the desired biological function; and (D) the specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including any number of proteins having essentially any structure and having RP-II activity. The scope of the claims must bear a reasonable correlation with the scope of enablement (*In re Fisher*, 166 USPQ 19 24 (CCPA 1970)). Without sufficient guidance, determination of the identity of proteins having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See *In re Wands* 858 F.2d 731, 8 USPQ2nd 1400 (Fed. Cir, 1988).

In support of their request that the analogous prior rejection be withdrawn, Applicants provide the following arguments, which are relevant here. The specification provides an extensive disclosure for producing the claimed polypeptides. The methods of making the claimed polypeptides and screening for RP-II protease activity are known in the art and described in the specification. The specification discloses a number of parent RP-II proteases (SEQ ID NOs: 2, 4, 6, 8, 10, 12 and 14) and numerous variants within the scope of the claims. Given the extensive guidance given in the specification and the high level of skill in the art, the experimentation

involved to produce other variants within the scope of the claims is routine and well within the skill of those in the art. A considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experiment should proceed."

These arguments are not found to be persuasive for the following reasons. It is acknowledged that a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance. It is also acknowledged that methods for making modified proteins and assays for RP-II activity were known in the art. However, the instant claims encompass any protein having essentially any structure and having RP-II activity. The making and testing of all said proteins possibly having the desired activity clearly represents undue experimentation.

Written Description

Claims 77 and 78 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. These claims are directed to the genus of proteins, having any structure with a substitution corresponding to H¹⁴⁴R of SEQ ID NO: 2, wherein the protein has RP-II activity. The specification teaches the structure of only a few representative species of such proteins. Moreover, the specification fails to describe any other representative species by any identifying characteristics or properties other than the functionality of having RP-II activity. Given this lack of description of representative species encompassed by the genus of the claim, the specification fails to sufficiently describe the claimed invention in such full, clear, concise,

and exact terms that a skilled artisan would recognize that applicants were in possession of the claimed invention.

In support of their request that the analogous prior rejection be withdrawn, Applicants provide the following arguments, which are relevant here. The claims have been amended. The specification describes a number of other positions, including specific mutations, which can be combined with any of the claimed modifications. Thus, the specification fully describes the RP-II protease variants of the present invention.

These arguments are not found to be persuasive for the following reasons. It is acknowledged that specification describes a number of positions that can be modified. However, the instant claims encompass any protein having essentially any structure and having RP-II activity. Description of said positions that can be modified fails to describe the full scope of any protein having any structure and having RP-II activity in a manner such that the skilled artisan would recognize that Applicants were in possession of the full scope of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 77 and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Norregaard-Madsen et al, 2001 (IDS). Norregaard-Madsen et al teach variants of RP-II proteases, including BCL, wherein the variants have at least 60% homology to the parent sequence or are encoded by a polynucleotide that hybridizes to the parent polynucleotide under very low stringency conditions (pg 17, para 2 to pg 19, para 1). The skilled artisan would believe that, more likely than not, said variants of Norregaard-Madsen et al encompass variants of any RP-II protease comprising a substitution corresponding to H¹⁴⁴R of SEQ ID NO: 2. Therefore, Claims 77 and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Norregaard-Madsen et al, 2001.

Claim 77 is rejected under 35 U.S.C. 102(b) as being anticipated by Sloma et al, 1990. Sloma et al teach a protease having an Asp substitution at the position corresponding to His¹⁴⁴ of SEQ ID NO: 2. Therefore, Claim 77 is rejected under 35 U.S.C. 102(b) as being anticipated by Sloma et al, 1990.

Claim 77 is rejected under 35 U.S.C. 102(a&e) as being anticipated by Ostergaard et al, 2003 (filing date 17-APR-2000). Ostergaard et al teach a protease having a Met substitution at the position corresponding to His¹⁴⁴ of SEQ ID NO: 2. Therefore, Claim 77 is rejected under 35 U.S.C. 102(a&e) as being anticipated by Ostergaard et al, 2003.

Allowable Subject Matter

No claims are allowable.

Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Any new references were cited solely to support rejection(s) based on amendment or rebut Applicants' arguments. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Regarding filing an Appeal, Applicants are referred to the Official Gazette Notice published July 12, 2005 describing the Pre-Appeal Brief Review Program.

Final Comments

To insure that each document is properly filed in the electronic file wrapper, it is requested that each of amendments to the specification, amendments to the claims, Applicants' remarks, requests for extension of time, and any other distinct papers be submitted on separate pages. It is also requested that the serial number of the application and date of amendment be referenced on every page of the response.

It is also requested that Applicants identify support, within the original application, for any amendments to the claims and specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SHERIDAN SWOPE/
Primary Examiner, Art Unit 1652